

REMARKS

This Application has been carefully reviewed in light of the Office Action mailed May 17, 2004. Claims 1-16 were pending in the application. Claims 1-16 stand rejected. Applicants respectfully request reconsideration and favorable action in this case.

Double Patenting Rejection

The Examiner rejects Claims 1-16 under the judicially created doctrine of obviousness-type double patenting as being unpatentable over the claims of U.S. Patent No. 6,690,508. Applicants submit herewith a Terminal Disclaimer in this Application with respect to U.S. Patent No. 6,690,508. Therefore, favorable action is respectfully requested.

Section 102 and 103 Rejections

Claims 9 and 11 are rejected under 35 U.S.C. §102(e) as being anticipated by U.S. Patent No. 6,246,514 to Bonnedal et al. (“*Bonnedal*”). Claims 10 and 12-16 are rejected under 35 U.S.C. §103(a) as being unpatentable over *Bonnedal*. Applicants have amended Claim 9 to include the limitations of Claim 10.

In rejecting Claim 10 (as well as Claims 12-16), the Office Action states that this claim recites “well known properties that would have been considered during control of a pump laser disclosed by Bonnedal et al.” However, Applicants respectfully submit that the Office Action does not indicate where *Bonnedal* or any other reference discloses controlling a pump laser based on an aging factor of the laser, as now recited in Claim 9. In addition, the Office Action provides no disclosure of a suggestion to modify the teachings of *Bonnedal* to disclose the limitations of amended Claim 9.

In order to establish a *prima facie* case of obviousness, three requirements must be met: (1) there must be some suggestion or motivation, either in the references themselves or in the knowledge available to one skilled in the art, to modify a reference or combine multiple references; (2) there must be a reasonable expectation of success; and (3) the prior art reference (or combination of references) must teach or suggest all of the claim limitations. M.P.E.P. §2143. In the present case, a *prima facie* case of obviousness cannot be maintained for at least two reasons. First, there is no suggestion or motivation in *Bonnedal* to modify the

reference as suggested by the Examiner (and no other references have been suggested to be combined with *Bonnedal*). Second, the Office Action has provided no reference that discloses the controlling a pump laser based on an aging factor of the laser.

The Examiner must point to some teaching, suggestion, or motivation in the prior art to combine or modify references to produce the claimed invention. M.P.E.P. §2143.01. The factual inquiry whether to combine or modify references must be thorough and searching. *See McGinley v. Franklin Sports, Inc.*, 262 F.3d 1339, 1351-52 (Fed. Cir. 2001). This factual question cannot be resolved on subjective belief and unknown authority, but must be based on objective evidence of record. *See In re Lee*, 277 F.3d 1338, 1343-44 (Fed. Cir. 2002). “The mere fact that references can be combined or modified does not render the resultant combination obvious unless the prior art also suggests the desirability of the combination.” M.P.E.P. §2143.01 (emphasis in original).

The governing Federal Circuit case law makes this strict legal standard even more clear. According to the Federal Circuit, “a showing of a suggestion, teaching, or motivation to combine . . . prior art references is an essential component of an obviousness holding.” *In re Sang-Su Lee*, 277 F.3d 1338, 1343 (Fed. Cir. 2002) (quoting *Brown & Williamson Tobacco Corp. v. Philip Morris Inc.*, 229 F.3d 1120, 1124-25 (Fed. Cir. 2000)). “Evidence of a suggestion, teaching, or motivation . . . may flow from the prior art references themselves, the knowledge of one of ordinary skill in the art, or, in some cases, the nature of the problem to be solved.” *In re Dembiczaik*, 175 F.3d 994, 999 (Fed. Cir. 1999). However, the “range of sources available . . . does not diminish the requirement for actual evidence.” *Id.* In *In re Dembiczaik*, the Federal Circuit reversed a finding of obviousness by the Board of Patent Appeals and Interferences, explaining that proper evidence of a teaching, suggestion, or motivation to combine is essential to avoid impermissible hindsight reconstruction of an applicant’s invention:

Our case law makes clear that the best defense against the subtle but powerful attraction of hind-sight obviousness analysis is *rigorous application of the requirement for a showing of the teaching or motivation to combine prior art references*. Combining prior art references without

evidence of such a suggestion, teaching, or motivation simply takes the inventor's disclosure as a blueprint for piecing together the prior art to defeat patentability—the essence of hindsight.

175 F.3d at 999 (quoting *W.L. Gore & Assoc., Inv. v. Garlock, Inc.*, 721 F.2d 1540, 1553 (Fed. Cir. 1983)) (emphasis added) (citations omitted).¹

Applicants respectfully submit that the Examiner has not provided evidence that controlling a pump laser based on an aging factor of the laser is in the prior art or, even assuming for the sake of argument that it is, that such a prior art teaching could properly be used to modify or be combined with *Bonnedal* to disclose each and every limitation of amended Claim 9. Therefore, Applicants respectfully submit that the Examiner has not established a *prima facie* case of obviousness and that Claim 9 and the claims that depend from it should be allowed. Favorable action is respectfully requested.

¹ See also *In Re Jones*, 958 F.2d 347, 351 (Fed. Cir. 1992) (“Conspicuously missing from this record is any evidence, other than the PTO’s speculation (if that can be called evidence) that one of ordinary skill in the herbicidal art would have been motivated to make the modification of the prior art salts necessary to arrive at” the claimed invention.).

CONCLUSION

Applicants have made an earnest attempt to place this case in condition for allowance. For the foregoing reasons, and for other reasons clearly apparent, Applicants respectfully request full allowance of all pending claims.

If the Examiner feels that a telephone conference would advance prosecution of this Application in any manner, the Examiner is invited to contact Brian W. Oaks, Attorney for Applicants, at the Examiner's convenience at (214) 953.6986.

No fee is believed to be due. However, the Commissioner is hereby authorized to charge any additional fees or credit any overpayment to Deposit Account No. 02-0384 of BAKER BOTTS L.L.P.

Respectfully submitted,

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